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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/030,844

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Robert Benjamin Franks

5897-000009

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27572 7590 01/10/2007  
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EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/030,844

Applicant(s)

FRANKS ET AL.

Examiner

Janice A. Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on May 7, 2002, wherein claims 33-59 are currently pending.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on September 23, 2004 is being considered by the examiner.

#### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in the United Kingdom on May 11, 2000 and July 14, 2000. It is noted, however, that applicant has not filed a certified copy of the applications as required by 35 U.S.C. 119(b).

#### ***Specification***

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

#### ***Claim Objections***

5. Claim 59 is objected to because of the following informalities: The claim language has terms like a said class selection icon, a said dialogue box. The claim language would read clearer if the applicant use said class selection icon or the class selection icon. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 34-38, 40-48, 50-53, and 56-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 34-38 depend on claim 1 which has been cancelled.

Claims 40-48 depend on claim 7 which has been cancelled.

Claims 50-53 depend on claim 17 which has been cancelled.

Claims 56-58 depend on claim 23 which has been cancelled.

7. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant states in the preamble that the invention is directed to a system allowing a user to file a trademark application. However, all that is presented in the claim language is the means for presenting and selecting the goods/services.

8. Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 39 has a limitation of selecting goods/services from a predetermined list.

Who selects the goods/services? The user?

Art Unit: 3629

9. Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what the applicant is claiming as the invention in this claim. Generally the interface has a display which displays a plurality of class selection icons.

10. Claim 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what the applicant is claiming as the invention. Is it the graphical user interface? An interface generally is part of a system, wherein the system comprises a processor and memory.

11. Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear which statutory class the invention falls in. The applicant states that it is a method of operation. Then applicant states that the interface comprises and presents structure. Further in the claim, the applicant states that the method comprises the steps of and presents method steps.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3629

12. Claim 59 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a method (ex. preamble of claim 1), the body of the claim discusses the specifics of the system of the interface, and subsequently the claim then deals with the specifics of a method (the steps). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 22 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Berke (US 6,629,092) (hereinafter referred to as Berke).

Referring to Claim 39:

Art Unit: 3629

Berke discloses a method of presenting and selecting goods/services forming part of a trademark application via an internet based system, the method comprising the steps of:

presenting a predetermined list of goods/services to a user of the system (col. 5, lines 22-44); and

selecting said goods/services from the predetermined list (col. 5, lines 22-44; col. 9, lines 39-46).

Referring to Claim 49:

Berke discloses user interface for generating an interactive display capable of receiving instructions for selection of individual goods/services, the interface comprising:

a plurality of class selection icons for selecting at least one class of goods/services wherein the interface is capable of receiving said instructions by selection of a class selection icon (Figure 4).

Referring to Claim 54:

Berke discloses a remotely accessible user interface for generating an interactive display capable of receiving instructions for selection of individual goods/services, said interface comprising:

at least on data processor (Figure 1);

at least on memory for storing data (Figure 1);

said interface configure to display information and receive instructions (Figure 1).

Referring to Claim 55:

Art Unit: 3629

Berke discloses a method of operation of a user interface for receiving instructions for selection of individual goods/services, said method comprising:

generating an interactive display of a plurality of class icons, each representing a class of goods/services (figure 4); and

selecting at least one class of goods/services by activating at least one of said class selection icon (col. 5, lines 31-44).

Referring to Claim 59:

Berke discloses method of operation of a remotely accessible user interface for generating an interactive display capable of receiving instructions for selection of individual goods/services, said user interface comprising:

at least one data processor (Figure 1);

at least one memory storing instruction for operating the processor (Figure 1);

at least on memory for storing data (figure 1);

The method comprising the steps of :

displaying a plurality of class selection icons for selecting at least one class of goods/services (Figure 4);

displaying a menu dialogue, listing a generic text description of goods/services corresponding to the class selection icon (Figure 4);

displaying at least one dialogue box display for entering text descriptions of goods/services (Figure 4); and



Art Unit: 3629

receiving instructions for selection of at least one class of goods/services by activating the selection icon selecting at least one class of goods/services (col. 5, lines 31-44).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berke in view of TEAS retrieved from the Internet Archive Wayback Machine.

Referring to Claim 33:

Berke discloses an internet based system, said system comprising:

means for presenting a predetermined list of goods/services to said user of said service system (Figure 1, Figure 3 (Step 41) and Figures 4-5)

means for selecting said goods/service from said predetermined list (Figure 1, col. 5, lines 31-44).

Berke does not disclose that the system is configurable to allow a user to file at least one trademark application.

However, TEAS teaches a system configured to allow a user to file a trademark application.

It would have been obvious to one of ordinary skill in the art to configure the trademark search engine of Berke with the filing taught in TEAS since the advent of the

Art Unit: 3629

Internet and advanced technology has lead the USPTO to now accept, in fact, encourage electronic filing.

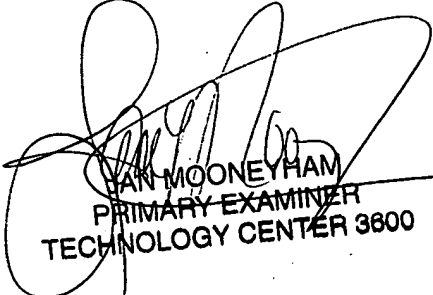
Moreover, claim 33 is directed to a system. The Examiner asserts that the computer system of Berke is fully capable of being configured to allow a user to file a trademark application.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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